

REMARKS

In this Amendment, Applicant has amended Claims 1, 2 and 13 to recite a computer having a computer readable medium with instructions stored thereon to provide the features of Applicant's point of sale system. Claim 19 has been amended to positively recite a computer network in the body of the claim and to recite a computer readable medium having instructions stored thereon to provide the claimed features of Applicant's point of sale system. Claim 31 has been amended to recite a computer readable medium having instructions programmed thereon to provide the claimed point of sale system functionality. The claim has also been amended to avoid specifying that the point of sale system functionality is necessarily resident on the server itself. Claim 42 has been amended to recite a computer readable medium having instructions programmed thereon to provide the claimed point of sale system functionality. The claim has also been amended to avoid specifying that the point of sale system functionality is necessarily resident on the claimed internet browser itself. Claims 43-45 and 52 have also been amended accordingly..

In addition, Claim 30 has been withdrawn from prosecution following Applicant's election of Claims 1-29. No claims have been canceled. Thus, claims 1-29 and 31-52 remain pending in the application.

As requested by the Examiner, Applicant is submitting herewith a Supplemental Response to the Requirement for

Information. In response to the Examiner's rejections under 35 U.S.C. § 103, Applicant is also submitting a Rule 132 Declaration of Gordon Michael Wiram herewith.

Rejection of Claims 31-52 Under 35 U.S.C. § 112

The Examiner has rejected Claims 31-52 as failing to comply with the written description requirement under 35 U.S.C. § 112. According to the Examiner, the claims improperly specified the location of Applicant's point of sale system functionality as on the server ("fat server-skinny client") or on the browser ("fat client-skinny server"). As amended, Claims 31-52 generally specify that the various claimed point of sale system features are resident on the system generally without specifying that they are necessarily resident on the server or browser. Thus, the amended claims are supported by the originally-filed specification, and reconsideration and withdrawal of the rejection is respectfully requested.

Rejection of Claims 1-29 and 42-52 Under 35 U.S.C. § 101

The Examiner has rejected Claims 1-29 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Reconsideration and withdrawal of the rejection is respectfully requested.

As amended, independent Claims 1-29 recite a computer having a computer readable medium with instructions stored

thereon to provide the various claimed point of sale system features. Similarly, amended Claims 42-52 recite a computer readable medium with instructions stored thereon to provide Applicant's various point of sale system features. According to the Office Action and as indicated by the Examiner during the above-referenced interviews, the recitation that the point of sale system features are resident on a computer readable medium renders the claims statutory.

While Applicant has amended Claims 1-20 and 42-52 to expedite their allowance, Applicant respectfully traverses the Examiner's statutory subject matter rejection. 35 U.S.C. § 101 provides that "Whoever invents or discovers any new and useful process . . . or any new and useful improvement thereof may obtain a patent therefore, subject to the conditions and requirements of this title." Further, a statutory "process" encompasses "[a] process, art or method" 35 U.S.C. § 100(b).

According to the Examiner "disembodied software elements, which are not tangible. . . are per se nonstatutory." Federal Circuit precedent makes clear that the physical limitations, such as computer hardware or a computer readable medium, are not required for claims to be statutory. The basis of the Examiner's rejection was specifically rejected by the Federal Circuit in AT&T Corp. v. Excel Communications, 172 F.3d 1352, 1357 (Fed. Cir. 1999). In AT&T, the claims at issue were directed to a telecommunications method utilizing a message

record for long-distance telephone calls which was enhanced by the addition of a primary interexchange carrier ("PIC") indicator. Id. at 1353. The claims were directed only to a message record--i.e., a data structure--and did not require any hardware limitations. Id. at 1354. Nevertheless, the Federal Circuit found that "[t]he PIC indicator represents information about the call recipient's PIC, a useful, non-abstract result that facilitates differential billing of long distance calls" Id. at 1358. As a result, the Court held that "all the claims fall comfortably within the broad scope of patentable subject matter under § 101." Id. at 1361. The Court specifically rejected the defendant's contention that the asserted claims were unpatentable because they lacked physical limitations, holding that "this type of physical limitations analysis seems of little value." Id. at 1359.

In support of his rejection, the Examiner cites In re Warmerdam, 31 USPQ2d 1754 (Fed. Cir. 1994). However, Warmerdam is inapposite and does not stand for the proposition for which it is cited. In Warmerdam, the applicant sought to patent a method for generating a data structure without limiting its claims to any useful application. The court held that "the claim involve[d] no more than the manipulation of abstract ideas." Id. at 1759. Here, Applicant has indisputably included limitations directed to a concrete, tangible, and useful application, the reservation and rental of equipment. Thus, contrary to the Examiner's assertion, the recitation of computer hardware or

network limitations or a computer readable medium in Applicant's claim is not necessary to satisfy 35 U.S.C. § 101, and the rejection should be withdrawn.

Rejection Under 35 U.S.C. § 103

The Examiner has rejected all pending claims as obvious over U-Haul's non-internet based point of sale system alone or in combination with Francisco, U.S. Patent No. 5,875,433. Reconsideration and withdrawal of the request is respectfully requested.

Applicant has submitted herewith the Rule 132 Declaration of Gordon Michael Wiram. As the Declaration indicates, notwithstanding whether the Examiner has presented a *prima facie* case of obviousness, the "Secondary Considerations" of non-obviousness demonstrate that the claimed invention is allowable over the references of record. In particular, the claimed internet-based point of sale system addressed several long felt but unsolved needs relating to the inability to quickly and uniformly update a POS system at a nationwide network of rental equipment centers and dealers. In addition, the ability to quickly and uniformly update the claimed POS system allowed for the successful adaptation of the system to quickly fluctuating market conditions, thereby providing economic gains. As a result, the claimed system has achieved a degree of commercial success which also demonstrates its non-obviousness.

Drawing Objections Under 37 C.F.R. 1.83(a)

The Examiner has objected to the drawings, contending that they do not show every feature of the claimed invention. As Applicant explained during the above-referenced interviews, the drawings do in fact show embodiments of each claim feature. For example, an embodiment of the claimed transfer feature is shown in Figures 23-27, an embodiment of the claimed return feature is shown in Figures 2, 4, 16 and 17, an embodiment of the claimed reporting feature is shown in Figures 33-35, and an embodiment of the claimed marketing section is shown in Figure 32. An embodiment of the claimed customer information section is shown in Figure 5, an embodiment of the claimed equipment information section is shown in Figure 25, and an embodiment of the claimed credit card payment section is shown in Figure 13.

In light of the Applicant's identification of the foregoing features in the drawings, the Examiner agreed to withdraw the drawing objections.

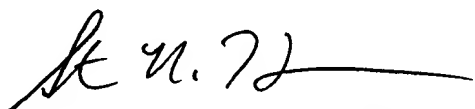
CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

Respectfully submitted,

JEFFER, MANGELS, BUTLER & MARMARO LLP

Dated: 1/12/2005

By: 
Steven R. Hansen, Esq.
Reg. No. 39,214
1900 Avenue of the Stars
Seventh Floor
Los Angeles, CA 90067-4308
(310) 203-8080